

REMARKS

Applicant thanks the Examiner for the careful review of this application. The Abstract and claims 1-2, 12-13 and 29 were amended. No new matter was added. Claims 5 and 7 were previously canceled without prejudice. Claims 1-4, 6 and 8-38 are currently pending in this application.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 1-4, 6, 8-11, 14-35 and 37 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Von Kohorn (U.S. Patent No. 5,697,844) in view of Storey (U.S. Patent No. 5,774,870) and further in view of Williams et al. (U.S. Patent No. 6,692,359). Claims 12 and 13 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Von Kohorn in view of Storey and further in view of Williams and still further in view of Atkins (U.S. Patent No. 5,644,727). Claims 36 and 38 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Von Kohorn in view of Storey and further in view of Williams and still further in view of Hunt (U.S. Patent No. 6,223,215).

The U.S. Patent and Trademark Office has issued guidelines for determining obviousness under 35 U.S.C. § 103 in view of the Supreme Court's decision in KSR International Co. v. Teleflex inc. (refer to Federal Register / Vol. 72, No. 195 at 57526). Consistent with past practice, however, the guidelines still require Examiners, when basing rejections on the combination of prior art, to articulate either 1) "a finding that the prior art included each element claimed," (refer to Federal Register / Vol. 72, No. 195 at 57529); or 2) "a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings." (Refer to Federal Register / Vol. 72, No. 195 at 57534.)

The Final Office Action indicates that Williams supplies an element claimed in the application but missing from the rejection of the Office Action of April 30, 2008.

Applicants submit this misinterprets Williams. The Final Office Action cites Williams at col. 1, line 62-col. 2, line 9 and Fig. 7, both of which are repeated here:

The invented method, applied to video games, includes the steps of creating a first visual representation of a first player on a first remote computer system, identifying an interest and a skill level of the first player for at least one 65 video game, indicating predetermined personal characteristics of the first player, saving the visual representation,

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interest, skill levels and personal characteristics of the first player, accessing the central computer system from the first remote computer system over telephone lines, selecting a second player who has accessed the central computer system 5 from a second remote computer system and inviting the second player to play a selected video game. The step of inviting allows the second player to access the visual representation, interest, skill levels and personal characteristics of the first player.

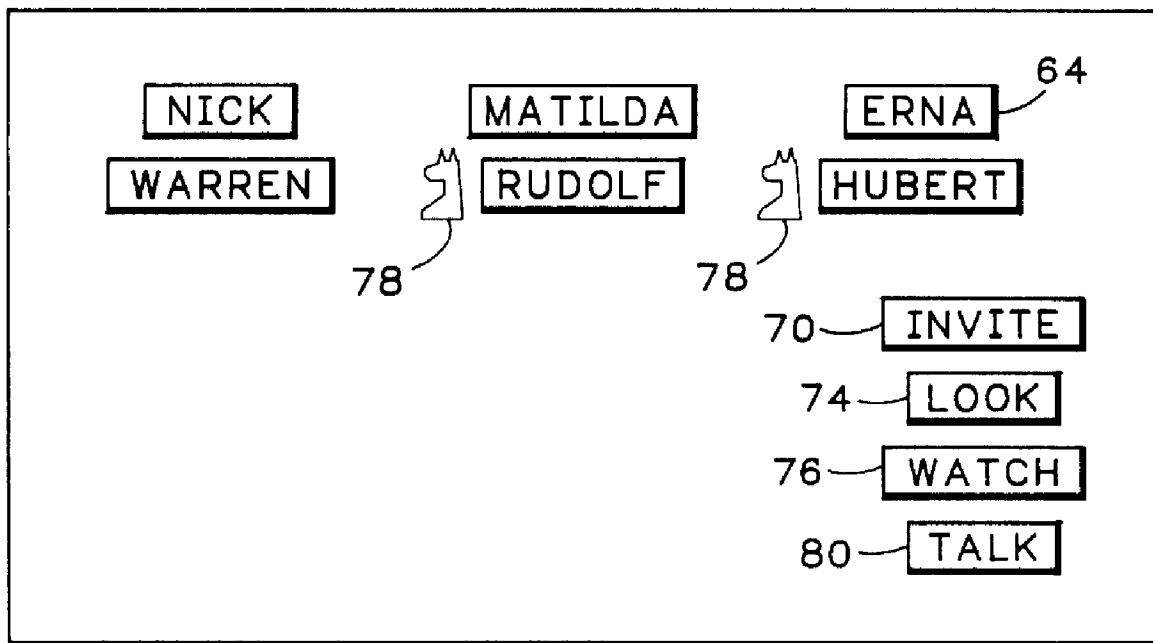


FIG. 7

The Final Office Action states:

plurality of game types. The feature of enabling a participant enabled to select a game type from a plurality of game types however is presented in the related network gaming device of Williams et al (Williams Figure 7, Col 1:62-2:9, "selected game"). It would

Final Office Action, p.3.

and thereby indicates that Williams provides for choosing a game from a plurality of differing games (e.g. "allowing a game to be played in exchange for a monetary input wherein the game is selectable from a plurality of differing games" – Claim 1, emphasis added). However, Williams speaks to the process of allowing someone (the second player) to determine if they want to play a game (e.g. Bridge) with players (or a player – the first player of Williams) of a certain skill level, with certain personal interests, or other personal characteristics. This suggests that the second player can choose a different Bridge game based on the idea that the second player wants to play with beginners who love dogs, rather than advanced players who do

not mention pets. The choice of what game to play is based on information about the potential players. Nothing in the cited section indicates that a different type of game is to be played, as the claim requires.

To the extent that the Final Office Action implies the claim language of a “plurality of differing games” does not require that the games be of different types, Applicant submits that this renders the amendment and difference between the prior claim language (“plurality of games”) a nullity. A plurality of games implies that the games have some differences, otherwise there would be no reason for a choice – the assignment would be to a random one of a plurality of games which have no difference. A plurality of differing games, as claimed and as described in the specification, means a plurality of games, each game of a different type. (See, e.g., § 105, “This number may be increased based on the amount of times a particular game is played, the number of times that different games are played, or by achieving a game-related goal...[.]”) One cannot play a different game multiple times, or the same game multiple times, if the choice of games is dependent on the skill levels and interests of other players, for example. The availability of other players would change and the game to be selected would no longer exist. This understanding of the claim language is reinforced by the language of the Final Office Action, stating “the combination of Storey and Von Kohorn does not explicitly teach that the participant is enabled to select a game type from a plurality of game types.”

invention as presented above however the combination of Storey and Von Kohorn does not explicitly teaches that the participant is enabled to select a game type from a plurality of game types. The feature of enabling a participant enabled to select a game

Final Office Action, p. 3.

Accordingly, not only does the combination not provide the missing element, but the combination teaches away from the claimed invention, leading along a path that does not provide the desired benefits of the claimed invention.

The claimed embodiments include methods for providing a game redemption system. One aspect of the methods, as reflected in the preceding amendment, is that a game may be selected and played from a plurality of differing games. While Applicant's specification does not explicitly state that the 'plurality of games' comprises 'differing games.' However, it is readily apparent to the skilled artisan that 'plurality of games' includes the embodiment of a 'plurality of differing games.' Support for this embodiment is implied, though, via Applicant's Fig. 3:

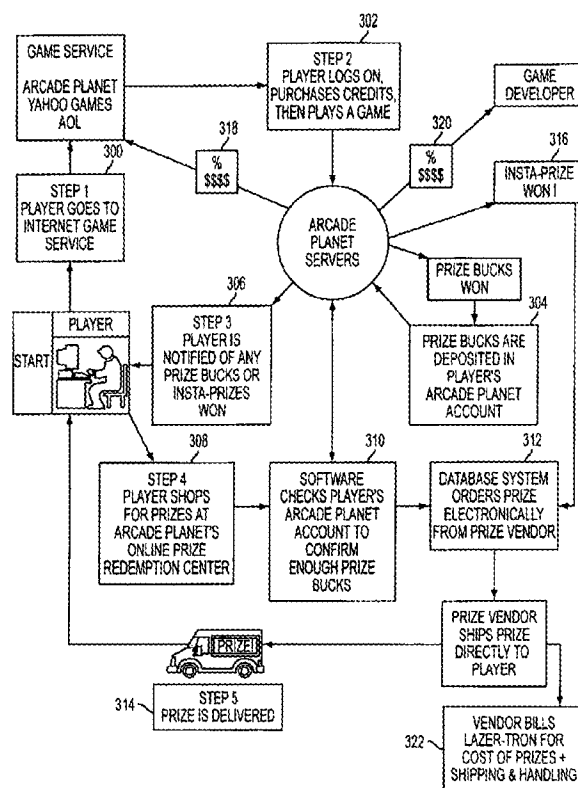


FIG. 3

Applicant's Fig. 3

Referring to the 'GAME SERVICE' box, above box 300, several example game services are listed thus indicating that a plurality of differing games are available to the user to choose from.

The Office Action primarily relies upon Von Kohorn in the 35 U.S.C. § 103(a) rejections of the claims and Von Kohorn, in the sections cited in the file history, simply does not disclose providing a user with a choice of differing games to select

from as cited by the Office Action. Likewise, in the sections cited in the file history, Storey does not disclose providing a user with a choice of differing games to select from. The Final Office Action admits as much at p. 3. Applicant submits that the Final Office Action does not remedy this missing element of the rejection with its citation of Williams, as pointed out above.

In view of the foregoing, Applicant respectfully requests withdrawal of the rejections of the claims.

CONCLUSION

Applicant believes that all pending claims are allowable and a Notice of Allowance is respectfully requested. Should the Examiner determine that a telephone conference would assist with this application, the Examiner is invited to contact the undersigned at 650.293.3352. Authorization is hereby granted to debit Deposit Account No. 50-3539 for any fees due, as a result of the submissions with this paper, as a result of lack of funds for any accompanying check, or for any other reason related to previous prosecution of this application.

Respectfully submitted,

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